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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,514	10/12/2001	Darrell Meyer	344.07-US-1	3496
34284	7590	05/19/2004	EXAMINER	
ROBERT D. FISH; RUTAN & TUCKER, LLP P.O. BOX 1950 611 ANTON BLVD., 14TH FLOOR COSTA MESA, CA 92628-1950			YIP, WINNIE S	
			ART UNIT	PAPER NUMBER
			3637	

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/890,514

Applicant(s)

MEYER, DARRELL

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29-42 and 47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-42 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to applicant's amendment filed on February 19, 2004.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of "the number of the sides (of the chord) is at least 6" (claim 41) must be shown or the features canceled from the claim. No new matter should be entered. The application only shows the chords having a cross section with 5-sides.

A proposed drawing correction and a replacing sheet of the corrected drawings are required in reply to the Office action to avoid abandonment of the application.

#### ***Claim Rejections - 35 USC § 103***

2. Claims 29-37, 39-42, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buecker '362 in view of Bodnar (US Patent No. 5,207,045)

Buecker shows and discloses a metal beam which is capable used as a joist, said beam comprising two chords having a polygonal cross-section with 5 planar sides which has a shape of irregular pentagon as claimed, a web connected and extending between the chords, the web having a plurality of openings (27), the web and the chords being formed by a single rolled sheet approximately 20-gauge steel (see col. 4, lines 10-21), the chord being formed from a continuous piece with a height greater than a width as claimed. However, Buecker does not

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define the web including stabilizing members being set of flanges that are projecting outward from punched out the openings on the web, and the punched out openings comprising at least forty percent of the area of the web as claimed. Bodnar teaches a metal beam having two chords connected by a web (103), said web having a plurality spaced apart stabilizing members which are formed by punched out openings (104) with flanges projecting outward the web, wherein the openings substantially formed at least forty percent of the area of the web. It would have been obvious to one ordinary skill in the art, at the time the invention was made, to modify the beam of Buecker having the web formed with a plurality of punched out openings at least 40 percent of the area of the web and having flanges projecting outward formed the opening as taught by Bodnar to provide stabilizing members on the web for providing a light-weight beam with stable properties.

Regard to claim 41, although either Buecker or Bodnar does not show the chords having at least 6 sides as claimed, however since applicant has not disclosed that the cross section of the chords having specific sides such as 6 sides rather than 5 sides solves any stated problems or it for any particular purpose. Moreover, it appears that the chord of Buecker would perform equally well with a polygonal cross section with specific 6 sides. Accordingly, it would have been an obvious matter of design choice to modify the beam of Buecker combined with Bodnar having the chords formed with suitable sides as claimed.

3. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buecker '362 in view of Bodnar '045 as applied to claims 29 and 31 above, and further in view of Brooks (US Patent No. 991,603).

Buecker in view of Bodnar teach all the limitation of the claimed invention as explained and applied above rejections except that either Buecker or Bodnar do not teach the beam having at least one chord being filled with a fill material. Brooks teaches a beam comprising two triangular chords (20) being connected by a web (19), wherein the chords are filled by heat resisting material (75). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the beam of Buecker combined with Bodnar having at least one chord being filled with suitable filling material such as heat resisting material as taught by Brooks for providing the beam with environmental protection to accommodate variety application.

#### ***Response to Amendment***

4. Applicant's arguments filed February 19, 2004 have been fully considered but they are not deemed persuasive. In response to applicant's argument that reference to Bodnar is a stud and is not a joist as now claimed, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, applicant only claims a weight bearing element, Bodnar and Buecker both teach a weight bearing element having substantial limitation as claimed, and both teach the weight bearing element can be used to joint with other beams, either to be used as a stud,

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therefore, it is examiner's position that the beams of Bodnar and Buecker are capable used in same art and are capable formed as a joist as claimed.

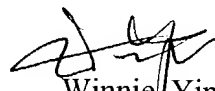
However, for further consideration, a new ground of rejection is set forth above.

### *Inquiry Contacts*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip  
Primary Examiner  
Art Unit 3637

wsy  
May 14, 2004